

**REMARKS**

Claims 1-17 are all the claims pending in the application. Claims 12 and 13 have been amended to provide antecedent basis for certain terms and are directed to form only.

Entry of the above amendments is respectfully requested.

**I. Response to Nonstatutory Obviousness-type Double Patenting Rejection**

Claims 1-17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 10/501,401 ("the '401 application") in view of Yoneyama et al. (US 5,362,482).

Applicants respectfully traverse the rejection

Claim 1 of the present application is directed to a preparation containing as necessary constituents (1) a specific ester compound, (2) an ester oil and (3) an ultraviolet protective powder, whereas the claims of the '401 application is directed to a preparation containing as indispensable constituents (1) a specific ester compound, (2) an ester oil, (3) a surfactant, (4) an oil other than an ester oil and (5) an water-soluble inorganic salt. The claims of the present application does not contain water-soluble inorganic salt as a constituent and the ultraviolet protective powder is not a constituent in the claims of the '401 application. Therefore, the claims are patentably distinct from each other.

Moreover, the inventions are utterly different from each other in problems to be solved by the invention and the effects of the invention.

A problem to be solved by the claimed invention is as follows, as described in paragraphs page 3, lines 6-25 and page 6, lines 5-12. Namely, ultraviolet protective powder is often commercially sold in a dispersed state in water or an oil. But, there has been a problem that the powder precipitates with time lapse. But, when the viscosity of such a dispersion is raised so as to inhibit this, the handling properties deteriorate and dispersibility into cosmetics

also decreases. Thus, the ability of the ultraviolet protective powder cannot be displayed, and moreover, there arises a possibility that the stability of the cosmetics is affected. The claimed invention aims to reconcile the stability and handling properties of a preparation in which an ultraviolet protective powder is dispersed. This reconciliation effect is demonstrated in the examples, particularly in Table 12.

On the other hand, a problem to be solved by the '401 application is as described in [0002]-[0007] and [0011]. Namely, a water-in-oil emulsion using mainly a hydrocarbon oil such as petrolatum as an oil has excellent moisture-confining properties, but poor in stability and use touch. On the other hand, an ester oil is good in use touch but not satisfactory in its moisture-confining properties. The '401 application aims to provide a water-in-oil emulsion preparation for external use on the skin satisfying all of the stability, use touch and moisture-confining properties. The '401 application is satisfactory in all of stability, use touch and moisture-confining properties. *See* [0104]. The effect of the '401 application is demonstrated in Examples, particularly in Table 5.

Thus, the claims are direct to inventions utterly different from each other in the problems to be solved by the invention and the effect of the invention, and therefore, the claims are patentably completely distinct from each other.

For at least the above reasons, withdrawal of the rejection is respectfully requested.

**II. Response to Rejection of Claims 12 and 13 under 35 U.S.C. § 112, second paragraph**

Claims 12 and 13 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite.

Claim 12 has been amended by changing "the storage elastic modulus" to "a storage elastic modulus" and "the loss elastic modulus" to "a loss elastic modulus". Claim 13 has been

amended to change "the area enclosed by the shear rate and shear stress" to "an area enclosed by the shear rate and shear stress".

In view of the amendments, withdrawal of the rejection is respectfully requested.

**III. Response to Rejection of Claims 1-8 and 12-16 under 35 U.S.C. § 103(a)**

Claims 1-8 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoneyama et al. (US 5,362,482) in view of Suzuki (US 6,759,052).

Applicants respectfully traverse the rejection.

Claim 1 is directed to an ultraviolet protective preparation comprising 0.1 to 10% by weight of an ester compound, 39.9 to 89.9% by weight of an ester oil and 10 to 50% by weight of an ultraviolet protective powder. The ester compound is an ester compound produced from glycerin and/or its condensate, a straight-chain saturated fatty acid having 2 to 28 carbon atoms and an aliphatic saturated dibasic acid having 12 to 28 carbon atoms and the ester oil is an oil agent which has a liquid or paste form at normal temperature and is produced from a carboxylic acid having a monovalent to hexavalent carboxyl group and 2 to 36 carbon atoms and an alcohol having monohydric to hexahydric hydroxyl group and 1 to 36 carbon atoms.

Claim 16 is directed to an ultraviolet protective preparation comprising 0.1 to 10% by weight of an ester compound, 39.9 to 89.9% by weight of an ester oil and 10 to 50% by weight of an ultraviolet protective powder. The ester compound is an ester compound produced from glycerin, behenic acid and eicosanic diacid, the ester oil is at least one of neopentyl glycol dicaprate, glyceryl tri-2-ethylhexanoate or pentaerythritol tetra-2-ethylhexanoate, and the ultraviolet protective powder is at least one of titanium dioxide, iron-containing titanium dioxide or zinc oxide.

It is respectfully submitted that Yoneyama does not disclose, teach or suggest every element of claim 1 or 16, and thus, a *prima facie* case of obviousness has not been established.

The present invention relates to an ultraviolet protective preparation. However, Yoneyama does not disclose an ultraviolet protective preparation. Yoneyama simply discloses a water-in-oil type emulsified solid composition containing (a) an oil component such as a silicone oil, (b) a solid wax and/or an oil-gelling agent, (c) water, and (d) (i) a polyoxyalkylene modified organopolysiloxane or (ii) a lipophilic surfactant and a hydrophobically treated powder, wherein the water content is 5% by weight or more, based upon the total amount of the composition.

Therefore, Yoneyama does not disclose, teach and suggest the ultraviolet protective preparation of the present invention.

In addition, Yoneyama discloses that an oil, such as pentaerythritol tetra-2-ethylhexanoate, can be used *in addition* to the silicone oils (that are usable in an amount of 30% to 100% by weight of the total oil component, column 5, lines 34-35). Thus, Yoneyama does not disclose, teach and suggest that pentaerythritol tetra-2-ethylhexanoate alone can be used in an amount of 5-85%.

Hence, Yoneyama does not disclose, teach or suggest every element of claim 1 or 16.

Furthermore, the composition of Yoneyama is different from the preparation of the present invention in the problems to be solved and the effects of the invention. Yoneyama does not disclose, teach and suggest the problem to be solved by the present invention or the effects of the present invention. Accordingly, Yoneyama does not disclose, teach and suggest not only the ultraviolet protective preparation of the present invention (claims 1-8, 12-13 and 16), but also the cosmetic comprising the ultraviolet protective preparation of the present invention (claims 14 and 15).

In addition, the Examiner asserts that "Yoneyama does not teach the specific ester compound. It is for this reason that Suzuki is added." However, Suzuki also does not disclose an ultraviolet protective preparation. Suzuki only discloses a cosmetic composition comprising,

component (A) and component (B), wherein, (A) is carboxylic acid ester of inulin and/or hydrolyzed inulin whose degree of substitution by aryl group is larger than 1, and (B) is cyclic silicone oil, and an oily cosmetic composition comprising, further powder blended as the component (C) aiming to perform makeup effect, and a W/O type emulsified cosmetic composition comprising, further emulsifier blended as component (D) and aqueous component blended as component (E). Therefore, Suzuki does not teach and suggest the ultraviolet protective preparation of the present invention.

The Examiner also states that "Suzuki teaches cosmetic compositions comprising ester compounds as an emulsifier, glycerin fatty acid surfactant (column 6, lines 34-39)." However, Suzuki only discloses glyceryl stearate, which is different from the ester compound of the present invention.

The Examiner further states that "The cosmetic compositions comprising Nomcort HK-G (3% [0.2%]) and isotridecyl isononate (0.2% [3%]) in the form of a cream (Example 46 in Suzuki). The amount of ester compound can range from 0.1-10% and provides a light feel, stability and fluidity when applied on the skin (column 7, lines 22-25)."

However, in Example 46 of Suzuki, Nomcort HK-G is contained as an optional ingredient, and not as emulsifier (component (D)). Nomcort HK-G does not have emulsification properties, and thus, Nomcort HK-G can not use as emulsifier (component (D)). The cream of Example 46 contains Poly(PEG/PPG/butylenes/dimethicone) copolymer and PEG-9 polydimethylsiloxymethyl dimethicone as emulsifiers (component (D)). Therefore, the Examiner's reliance on the disclosure of column 7, lines 22-25 to Nomcort HK-G is misplaced.

In addition, isotridecyl isononate is also contained as an optional ingredient, and not as component (A)- (E). Thus, it is believed that isotridecyl isononate has no relation to the object of the composition of Suzuki. Furthermore, the cream of Example 46 does not contain an

ultraviolet protective powder, which is an important component of the present invention.

Accordingly, Example 46 is irrelevant to the present invention.

Furthermore, there is no motivation to combine Yoneyama and Suzuki to arrive at the claimed invention. In this regard, the combination of Yoneyama and Suzuki appears to be based on improper hindsight.

Moreover, Suzuki also does not disclose, teach and suggest the problem to be solved by the present invention or the effects of the present invention.

Accordingly, one of ordinary skill in the art would not arrive at the present invention by combining Yoneyama and Suzuki with a reasonable expectation of success, particularly in order to solve the problem of the present invention and achieve effect of the present invention.

For at least the above reasons, it is respectfully submitted that claims 1-8, 12-13 and 16 are patentable over the cited art.

Accordingly, withdrawal of the rejection is respectfully requested.

**IV. Rejection of Claims 9-11 and 17 under 35 U.S.C. § 103(a)**

Claims 9-11 and 17 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Yoneyama et al. (US 5,362,482) in view of Suzuki (US 6,759,052) and in further view of Miyoshi et al. (US 5,968,531).

Applicants respectfully traverse the rejection.

Since claims 9-11 and 17 depend from claim 1 or 16, it is respectfully submitted that these claims are patentable for at least the same reasons as claim 1 or 16.

Accordingly, withdrawal of the rejection is respectfully requested.

**V. Conclusion**

In view of the above, reconsideration and allowance of claims 1-17 is respectfully requested.

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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